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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:
M. Seul et al.

Serial No. 09/448,420

Filed: 11/22/1999

For: Color-Encoding and in-situ
Interrogation of Matrix-Coupled
Chemical Compounds

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) Group Art Unit: 1639
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) Examiner: P. Ponnaluri
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Commissioner for Patents
PO Box 1450
Alexandria VA 22313-1450

VIA FAX: (703) 872-9306

Petition for Examiner to Issue New and Proper Final Rejection

Dear Sir:

Following a Final Rejection of all claims (129-152, 154-166 and 168-174) in this matter, two Responses After Final and two Advisory Actions, and two conferences with the Examiner's supervisor (Andrew Wang), on January 15, 2004, Applicants filed a Notice of Appeal and an Appeal Brief in this matter. On February 18, 2004, the undersigned returned the Examiner's call, and was told that dependent claim 173 recited allowable subject matter and the application would be allowed if claim 173 was rewritten as an independent claim (and, presumably, on further condition that all other claims were canceled).

Applicants believe that the Examiner has not followed the required procedure in this matter. For example, Rule 1.113(c) requires:

Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

Thus, the Examiner's suggested procedure would forego the required procedures, wherein Applicants could cancel or appeal from the rejected claims, or write claim 173 as a dependent claim in response to a final rejection, and not after an appeal notice and brief have already been filed. Accordingly, Applicants petition to have this matter returned to the Examiner so that she can, if she deems it appropriate, issue a new Final Rejection, thereby providing Applicants the opportunity to respond in accordance with the required procedures. Any other procedure is not providing Applicants the right to prepare their appeal brief properly in this matter. The brief now on file includes arguments for allowability of claims which the Examiner now concedes are allowable, and thereby is a distraction to the appellate tribunal, and prevents them from focusing properly on the agreed "real" issues in this case. This would be unfairly prejudicial to Applicants.

Applicants wish to note that Rule 1.191(e) provides authority for returning this matter to the Examiner for issuance of a new Final Rejection: "the Commissioner may *sua sponte* order the application remanded to the examiner." In the alternative, the parties could discuss allowance of the only independent claim, i.e., 129, to move this matter forward.

Respectfully submitted,

Dated: 2/20/2004

By:



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